

REMARKS

This responds to the Office Action mailed on June 15, 2005, and the references cited therewith.

Claims 1 and 9 are amended, claims 5, 6, and 8 are canceled; as a result, claims 1-4, 7, and 9 are now pending in this application.

§103 Rejection of the Claims

Claims 2 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rodkin.

Applicants respectfully submit that claims 2 and 7 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 is rewritten to include the following limitation from claim 5:

communicating the name of the product to a producer of the text, wherein the name of the product is designated from a plurality of names of the product that are utilized by the producer of the text.

The Office Action, in rejecting claim 1, offers the following description from Rodkin:

The method may comprise the further steps of receiving designated character strings from the primary computers via the communication network in the periodic maintenance mode; wherein the designated character strings are designated by an administrator input

at the primary computers; updating the annotation database with the designated character strings if the designated character strings are not present in the annotation database.

Col. 10, lines 25-32.

The Office Action, in rejecting claim 1 states that Rodkin does not explicitly teach the limitations of claim 1, nevertheless the above quote from Rodkin is offered and describes a method for receiving a character string from a primary computer. The character string is designated by an administrator at a primary computer (e.g., Figure 5, content server 410) and communicated by the primary computer to a central computer (e.g., Figure 5, central server 450, Col. 9, line 64). The central computer receives the character string and, if the character string is not present in the annotation database, updates the character string to the annotation database.

In addition to offering the above quote from Rodkin the Office Action states that it would have been obvious for the administrator to designate a product to producers of the product so that the producers could provide their readers with further information about their product.

Claim 1 requires communicating a name of a product to a producer of a text where the name of the product is designated from multiple names of the product that are utilized by the producer of the text. For example, in one embodiment a web site (e.g., a producer of text) may publish web pages that advertise a sale of a vacuum cleaner named "XYZ S3755 WindStorm Bagless Canister Vacuum," "S3755" and "WindStorm." Continuing with the example, the name "WindStorm" may be designated from the listed names and communicated back to the web site.

In contrast to the limitations of claim 1, the above quote from Rodkin does not describe communicating a name of a product to a producer of a text where the name of the product is designated from multiple names of the product that are utilized by the producer of the text; but rather, communicating a character string to a central computer for updating to an annotation database. Indeed, Figure 5 from Rodkin (e.g., callout 530) illustrates the primary computer (e.g., content server 410) and not the central computer (e.g., central server 450) as receiving articles. Further Rodkin describes the content server 410 as receiving the articles (e.g., data) from "a publisher or the like" (Rodkin Col. 14, lines 34-36) but nowhere does Rodkin describe communicating to the "publisher or the like," much less communicating a name of a product to a producer of text where the name of the product is designated from multiple names of the product that are utilized by the producer of the text. In addition, the above quote from Rodkin describes

the designation of a character string which is not a designation of a *product name* as required by claim 5. Further, the designation in claim 5 is made from *multiple product names that are utilized by producers of a text*. In contrast, the above quote merely describes the designation of a character string without mentioning a context in which such a designation may be made. Further, in rejecting the limitations of claim 1 the Office Action makes reference to producers of a product; however, the claim 1 is not directed to producers of a product; but rather, *producers of a text*. Rodkin therefore cannot be said to suggest the above quoted limitation because Rodkin discloses the communicating a designated character string to a central computer for optional storage in an annotation database and claim 1 requires communicating a name of a product to a producer of text where the name of the product is designated from multiple names of the product that are utilized by the producer of the text.

The above remarks are also applicable to a consideration of independent claim 9. Accordingly, Applicant requests that the above remarks and amendments contained herein also be considered when examining this other independent claims for allow ability.

If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of dependent claims 2 and 7 under 35 U.S.C. § 103 is also addressed by the above remarks.

§102 Rejection of the Claims

Claims 1, 3-4 and 9 were rejected under 35 U.S.C. § 102(b) for anticipation by U.S. 6,092,074 (hereinafter Rodkin).

Rodkin does not disclose each and every limitation of the claim 1 of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Claim 1 includes the following limitation:

communicating the name of the product to a producer of the text, wherein the name of the product is designated from a plurality of names of the product that are utilized by the producer of the text.

Rodkin does not describe the above limitation of claim 1, as required to support a rejection of this claim under 35 U.S.C. § 102(e).

The above remark is also applicable to a consideration of independent claim 9. Accordingly, Applicants request that the above remark and amendments contained herein also be considered when examining independent claim 9 for allow ability.

As dependent claims are deemed to include all limitations of claims from which they depend, the rejection of claims 3 and 4 under 35 U.S.C. § 102(e) is also addressed by the above remark, and the amendments contained herein.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-846-8871 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11 day of October, 2005.

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